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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,495	12/13/2000	Louis A. Schick	20-LC-2099/624226.289	3646

7590 08/15/2005

Enrique J. Mora, Esquire
Beusse, Brownlee, Bowdoin & Wolter, P.A.
390 North Orange Avenue, Suite 2500
Orlando, FL 32801

EXAMINER	
FISHER, MICHAEL J	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/736,495	SCHICK ET AL.	
	Examiner	Art Unit	
	Michael J Fisher	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-4,10,12-14 and 20-25 directed to the same invention as that of claims of commonly assigned patent US PAT 6,301,531 to Pierro et al. (Pierro). The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

Claims 1-4,10,12-14 and 20-25 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims of prior U.S. Patent No. 6,301,531 to Pierro et al. (Pierro). This is a double patenting rejection.

As to claims 1,20,21,22, Pierro discloses a method of managing a plurality of mobile assets (title), collecting data (section (a) in claim 1), processing the data to develop historical information regarding usage (sections (c),(d),(e) and (f) in claim 1), using the data to develop a failure prediction (claim 1, section (f)), distributing the information via data link to a global network (col 4, lines 7-9). It would be inherent that such a system would increase the performance and operating life of the mobile asset as this is the object of good maintenance.

As to claim 2, Pierro discloses using environmental data (operating parameters, col 4, lines 24-31).

As to claim 3, Pierro discloses determining a service recommendation based on the actual usage (claim 7, section (e)).

As to claim 4, Pierro discloses recommending services (section (d) in claim 8).

As to claim 10, Pierro discloses using the data to develop information regarding service functions (claim 1, sections (c)-(f)).

As to claim 12, Pierro discloses identifying trends (claim 1, section (d)), developing a service recommendation (claim 8, section (d)).

As to claim 13, Pierro disclosed the analyzing step as being on-board the mobile asset (col 3, lines 42-45).

As to claim 14, Pierro discloses the analyzing step as being remote from the mobile asset (claim 1, section (a)).

As to claims 23-25, Pierro further discloses a plurality of sensors (claim 5) and memory and data processor for recording data (118).

As to claims 37 and 40-45, Pierro discloses the system as being used for locomotives (fig 1).

Claim Rejections - 35 USC § 102

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 1-4,10,12-14 and 20-25 rejected under 35 U.S.C. 102(g) as being anticipated by US PAT 6,301,531 to Pierro et al. (Pierro).

As to claims 1,20,21,22, Pierro discloses a method of managing a plurality of mobile assets (title), collecting data (section (a) in claim 1), processing the data to develop historical information regarding usage (sections (c),(d),(e) and (f) in claim 1), using the data to develop a failure prediction (claim 1, section (f)), distributing the information via data link to a global network (col 4, lines 7-9). It would be inherent that such a system would increase the performance and operating life of the mobile asset as this is the object of good maintenance.

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As to claim 13, Pierro disclosed the analyzing step as being on-board the mobile asset (col 3, lines 42-45).

As to claim 14, Pierro discloses the analyzing step as being remote from the mobile asset (claim 1, section (a)).

As to claims 23-25, Pierro further discloses a plurality of sensors (claim 5) and memory and data processor for recording data (118).

As to claims 37 and 40-45, Pierro discloses the system as being used for locomotives (fig 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-9,11,15-19 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierro.

As to claims 5,6 and 8, Pierro discloses where the asset should be stopped (claim 7, section (e)), therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by recommending a service center as Pierro discloses determining where to stop the asset and therefore, a close service center would be appropriate.

As to claims 7,18, it is very well known in the art for companies with mobile assets to have an agreement with a particular service agent. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by providing a dedicated service chain to be able to get a reduced rate for quantity.

As to claim 9, it would be obvious to one of ordinary skill in the art to use cargo as one of the parameters (claim 5) as cargo affects the weight carried and would therefore, affect engine and suspension performance.

As to claim 11, Pierro does not disclose using the Internet to disseminate information. It is very well known to connect computers to the Internet. Therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to disseminate information as Pierro discloses using a computer (119) and it would make accessing the information more convenient.

As to claims 15-17 and 19, it is very well known in the art for public transportation assets to be compliant with regulatory requirements, to ensure safety. Therefore, it would have been obvious to one of ordinary skill in the art to modify the system as disclosed by Pierro by notifying about regulatory requirements to ensure that the company does not get fined for exceeding limits, as Pierro discloses the system as being useful for notifying the user about required maintenance.

As to claims 26,27, it is very well known in the art for companies to establish a cost/benefit analysis to ensure profitability. Therefore, it would have been obvious to one of ordinary skill in the art to use a cost-benefit analysis to ensure profitability for the enterprise.

As to claims 27 and 28, it is inherent that the value of an asset changes with usage and service. Further, it is inherent for companies to assess the value of assets for tax and business purposes. Therefore, it would have been obvious to one of ordinary

skill in the art to modify the system as disclosed by Pierro by calculating the value of the mobile assets for tax and business purposes.

As to claim 29, Pierro discloses predicting services based on past services (claim 8, section (d)).

As to claim 30, it is inherent that a company would assess the remaining warranty coverage else the company could pay for a repair that is covered by any warranty.

As to claim 31, warranty coverage is inherently based on service recommendations. For instance, if a warranty requires regular oil changes and the oil is not changed, the warranty could be voided.

As to claims 32,38,39,46 and 47, Pierro discloses the system as being used for locomotives (fig 1).

As to claim 33, Pierro further teaches knowing the location of the locomotive (col 3, lines 21-24) and using the Internet (col 4, lines 56-57). Pierro does not teach using a map of locations. It would have been obvious to one of ordinary skill in the art to use the Internet as this is well known in the art as a good way to transfer data. It would further be obvious to one of ordinary skill in the art to include a map to make it easier to know where the assets are as Pierro discloses knowing where they are.

As to claim 34, as discussed above, Pierro discloses making this information available on-line, therefore, it would have been inherent to include using hyperlinks if the information were on the Internet as this is how the Internet is navigated.

As to claim 35, Pierro discloses processing the data to identify a potential failure (col 4, lines 48-52).

As to claim 36, Pierro discloses automatically issuing an abnormal condition alert in response to data (col 4, lines 40-47) and further discloses making the data available online (col 4, lines 56-57).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PAT 6,480,810 to Cardella et al., Cardella et al. disclose a method of remotely monitoring a fleet, US PAT 6,330,499 to Chou et al., Chou et al. disclose a system and method for vehicle diagnostics and health monitoring.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Fisher whose telephone number is 703-306-5993. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
5/16/05

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600